

# RS
14

3-31-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 016778/0398

Applicant: Ryuichi KATAYAMA

Title: OPTICAL SYSTEM FOR DETECTING DATA SIGNAL AND TRACKING ERROR SIGNAL

Serial No.: 09/442,773

Filed: November 18, 1999

RECEIVED

Examiner: Unknown

MAR 28 2003

Art Unit: 2653

Technology Center 2600

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §1.56 and 37 CFR §1.97**

Commissioner for Patents
Washington, D.C. 20231

Sir:

Submitted herewith on Form PTO SB/08 is a listing of documents known to Applicant in order to comply with Applicant's duty of disclosure pursuant to 37 CFR 1.56. A copy of each listed document is being submitted to comply with the provisions of 37 CFR 1.97 and 1.98.

The submission of any documents herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicant does not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a prima facie prior art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The instant Information Disclosure Statement is believed to be filed in accordance with 37 C.F.R. 1.97(b), prior to the mailing date of a first Office Action on the merits (first scenario). If that is not the case, such as in a second scenario in which a first Office Action on the merits has been mailed before the filing of the instant Information Disclosure Statement, then either a certification or fee is required, and a certification is provided below. If neither of the first or second scenarios is the case, such as if a final Office Action or a notice of allowance has been mailed by the PTO (third scenario), then both a certification and fee are required, and in that case a certification is provided below and also the PTO is authorized to obtain the necessary fee to have the instant IDS considered, from Foley & Lardner Deposit Account #19-0741.

CERTIFICATION

The undersigned hereby certifies in accordance with 37 C.F.R. §1.97(e)(1) that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three (3) months prior to the filing of this Statement.

RELEVANCE OF EACH DOCUMENT

A translation of a portion of a Japanese Office Action that issued January 7, 2003 with respect to a counterpart Japanese patent application is provided below.

→ "The inventions related to Claims 1 through 14 of the present application could have been easily invented prior to this application by a person having ordinary knowledge in the technical field related to the invention based on the inventions described in the following publications, which had been circulated in Japan prior to that application. Therefore, a patent cannot be granted pursuant to the stipulations of Article 29, Section 2 of the Japan Patent Law.

Note

Cited literature

- new copy*
- 1. Japanese Unexamined Patent Application Publication S60-157737
 - 2. Japanese Unexamined Patent Application Publication S61-248240
 - 3. Japanese Unexamined Patent Application Publication H4-355221
 - ✓ 4. Japanese Unexamined Patent Application Publication H9-245356
 - ✓ 5. Japanese Unexamined Patent Application Publication H10-269588

Remarks

Refer to the "Abstract" on page 2 lower right column and to Figure 5 of Cited Example 1.

Refer to the "Action" on page 2 lower right column and page 3 upper left column line 20 through upper right column line 1, and to Figure 1 of Cited Example 2.

Refer to Figure 1 of Cited Example 3.

Refer to paragraphs 0019 through 0025 and 0037 through 0038, and to Figures 6 and 7 of Cited Example 4.

Refer to paragraphs 0055 through 0060, and to Figures 1 through 3 of Cited Example 5.

Here, in addition to the fact that no unique effect based on using the configuration of the invention of the present application has been demonstrated at all (Refer to "Reason A" above.), no unique difference can be discovered whatsoever between the inventions related to Claims 1 through 14 of the present application and the configurations described in Cited Examples 1 through 5, which all detect two types of tracking error signals, focus error signals, and information signals using the full reflected light from the optical recording medium.

The invention related to Claim 1 of this application is the same as the invention described in the specifications or diagrams initially attached to the patent application form below, which was a patent application dated prior to the present application, and which was disclosed after submission of the present application.

Moreover, the inventor of the present application is not the same as the person that made the aforementioned invention related to the patent application of a prior date, and at the time of the present application, the applicant was not the same as the applicant of the aforementioned patent application. Therefore a patent cannot be granted based on the stipulations of the Japan Patent Law Article 29, Section 2.

Note

Prior application

6. Japanese Patent Application H10-56167 (Refer to Japanese Unexamined Patent Application Publication H11-238234.)

Remarks

Refer to paragraphs 0016 through 0017 and 0020 through 0021, and to Figure 2 in Prior Application 6."

Applicants' statements regarding the Japanese Office Action are based on a partial translation that Applicants' representative obtained. These statements should in no way be considered as an agreement by Applicant with, or an admission of, what is asserted in the Japanese Office Action.

Applicant respectfully request that the listed document be considered by the Examiner and formally be made of record in the present application and that an initialed copy of Form PTO SB/08 be returned in accordance with MPEP §609.

Respectfully submitted,

27 March, 2003
Date

Phillip J. Articola
Phillip J. Articola
Registration No. 38,819

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109
Telephone: (202) 672-5300
Facsimile: (202) 672-5399